UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,943	12/28/2001	Brian L. Jackson	82274.102	8965

24347 7590 07/03/2007

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1601 BRYAN STREET
ENERGY PLAZA - 30TH FLOOR
DALLAS, TX 75201

EXAMINER	
JEANTY, ROMAIN	
ART UNIT	**PAPER NUMBER**
3623	

MAIL DATE	DELIVERY MODE
07/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/033,943
Filing Date: December 28, 2001
Appellant(s): JACKSON ET AL.

Thomas E. Anderson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 20, 2007 appealing from the Office action mailed September 05, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary Of the Invention

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 24-28, 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Sturgeon et al Sturgeon et al (U.S. Patent No. 5,726,884).

As per claim 1, Sturgeon et al discloses an integrated hazardous substance tracking and compliance. In so doing, Sturgeon et al discloses a database identifying a plurality of compliance events and a plurality of resources (col. 9, lines 32-51).

providing a computer system including a main computer and a remote computer adapted to communicate with the main computer, at least a portion of a main program and the database accessible by the main computer, the remote computer accessing a remote program operative to display and modify only a remote portion of the plurality of compliance events and only a remote portion of the plurality of resources of the database (col.10, lines 39-60, lines), periodically scanning the database to identify at least one of the plurality of compliance events requiring a response, scanning the database to identify at least one of the plurality of resources to respond to the compliance event requiring the response (col. 49, lines 35-61), matching at least one of the plurality of resources with the compliance event requiring the response (col. 29, line 64 through

col. 30 line 26), and scheduling the resource to respond to the compliance event (i.e., planning a response to the event) (col. 32, lines 27-44).

As per claim 2, Sturgeon et al further discloses wherein scheduling the resource to respond to the compliance event further includes sending the remote portion of at least one of the plurality of compliance events and the remote portion of at least one of the plurality of resources to the remote computer, and updating the compliance event with a completion information (col. 10, lines 39-51).

As per claim 3, Sturgeon et al further discloses wherein the remote computer is associated with at least one of the plurality of resources scheduled to respond to the compliance event and wherein the scheduling of the resource to respond to the compliance event is communicated to the remote computer (col. 32, lines 27-44).

As per claim 4, Sturgeon et al further discloses wherein the method further includes generating a report including the compliance events scheduled and the completion information (col. 10, lines 39-51).

As per claim 5, Sturgeon et al further discloses updating a follow-up information associated with the compliance event (col. 28, lines 34-39).

As per claim 6, Sturgeon et al further discloses matching the resource with the compliance event includes associating a location of the compliance event with a location of the resource. (col. 12, lines 54-61 and col. 29, line 64 through col. 30 line 26).

Claim 24 is a computerized method of managing a compliance event for a natural gas distribution system, the compliance event including at least one of a cathotic protection event, a danger tags event, a poly-pipe event, an odorant injection event, and a service line scheduling

event, for performing the steps of claim 1; therefore, claim 24 is rejected under the same rationale relied upon of claim 1.

As per claim 25, Sturgeon et al further discloses wherein the compliance event includes a priority and a unit (col. 29, lines 37-39 and col. 31, lines 27-38).

As per claim 26, Sturgeon et al further discloses wherein periodically scanning the database to identify compliance event requiring a response includes selecting the compliance event requiring a response based upon the priority (col. 29, lines 37-39 and col. 31, lines 27-38).

As per claim 27, Sturgeon et al further discloses wherein identify one of the plurality of resources to respond to the compliance event requiring the response further comprises determining the unit associated with the compliance event, identifying at least one of the plurality of resources associated with the unit of the compliance event requiring the response (col. 29, lines 37-39 and col. 32, lines 27-38).

Claim 28 is a compliance management system for managing compliance of a natural gas distribution system which claims the same limitations of claim the steps of claim 1, with the only difference that claim 1 does not claim the step of a remote program having an interface operative to display and periodically update the portion of the compliance event to be performed by the resource such that when the main program is modified to operatively maintain the plurality of compliance events and the plurality of resources, only the interface of the remote program is modified for the interface to operatively display and update the compliance event to be performed by the resource. In addition, Sturgeon et al disclose such claimed limitations. Note col. 1, lines 16-29, col. 23, line 60 through col. 24 line 14, and col. 26, lines 17-25 of Sturgeon

As per claim 38, Sturgeon et al discloses an integrated hazardous substance tracking and compliance. In so doing, Sturgeon et al discloses:

In so doing, Sturgeon et al discloses maintaining a database identifying at least one compliance event and a resource col. 9, lines 32-51), scanning the database on a periodic basis to determine the compliance event to be performed, associating the compliance event with the resource to perform the compliance event based upon a unit associated with both the compliance event and the resource (col. 49, lines 39-51), scheduling the resource to perform the compliance event; entering a completion information of the compliance event based upon completion of the compliance event by the resource (col. 32, lines 27-44), and generating a report including at least one compliance event and a portion of the completion information of the compliance event (col. 30, lines 27-56).

As per claim 39, Sturgeon et al further discloses wherein scheduling the resource to perform the compliance event includes: providing a remote computer associated by the resource; downloading to the remote computer the schedule of the resource to perform the compliance event; displaying the schedule of the resource to perform the compliance event; and performing the compliance event (col. 30, lines 27-44, and col. 32, lines 27-44).

As per claim 40, Sturgeon et al further discloses entering completion information into the remote computer, providing a main computer, the remote computer adapted to communicate with the main computer, transmitting from the remote computer to the main computer the completion information col. 30, lines 27-44, and col. 32, lines 27-44), and updating the compliance event with the completion information indicative of the compliance event being performed by the resource (col. 10, lines 1-19).

As per claim 41, Sturgeon et al further discloses creating a report including at least one of the plurality of compliance events and the completion information associated with at least one of the compliance events, printing the report on the main computer (col. 30, lines 27-44).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 7-23, 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturgeon et al (U.S. Patent No. 5,726,884) in view of Dialog (Santa Fe Pacific Corp).

As per claim 7-10, Sturgeon discloses all of the limitations in claims 1 and 2 above, but fails to explicitly disclose the concept of using a cathotic protection events. Dialog in the same field of endeavor discloses the concept of a cathotic protection events. Note page of Dialog. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the disclosures of Sturgeon et al to include a cathotic events as taught by Dialog with the motivation to efficiently and effectively comply with environmental regulations.

Regarding claims 11-23, the claimed features are standard practice in the natural gas distribution compliance management. Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to include such features in Sturgeon et al in order to efficiently and effectively comply with environmental regulations.

As per claim 29, Sturgeon does not explicitly discloses wherein the plurality of compliance events are selected from a group of compliance event consisting of a plurality of cathotic protection events, a plurality of danger tag events, a plurality of poly-pipe events, a plurality of odorant injection events and a plurality of service line scheduling events. However, including these features into the disclosure of Sturgeon et al would have been obvious to a person of ordinary skill in the art in order to efficiently and effectively comply with environmental regulations.

As per claim 30, Sturgeon et al further discloses wherein each of the plurality of compliance events having a priority and a unit (col. 29, lines 37-39 and col. 31, lines 27-38).

As per claim 31, Sturgeon et al further discloses wherein the priority of each of the compliance events is associated with a time-frame for responding to the compliance event (col. 29, lines 37-39 and col. 31, lines 27-38).

As per claim 32, Sturgeon et al further disclose wherein the unit is further defined as one of a plurality of geographical areas associated with each of the plurality of compliance events and resources and wherein the scheduling program is operative to schedule based upon the unit associated with the resources to perform the compliance events (col. 29, lines 37-39 and col. 32, lines 27-38).

As per claims 33-37, Sturgeon et al does not explicitly disclose wherein the remote computer further defined as a laptop computer, a personal digital assistant, a wireless device, a wireless telephone, a wireless device further defined as a pager. However these devices are well

known communication devices that are used for communication purposes. Thus, it would have been obvious to a person of ordinary skill in the art to modify the disclosures of Sturgeon et al to include these types of communications means in order to send and receive information.

(10) Response to Argument

Appellants asserted that Sturgeon et al fail to teach appellants' claimed invention. Appellants further supported their assertion by arguing on page 18 that Sturgeon does not discuss the scheduling of resources for its commitments. In response, the examiner respectfully disagrees. Sturgeon discloses a human resource management system for scheduling resources in the event of an emergency. For example Sturgeon teaches a human resource management grouping (training, exposure limits, etc.), a hazardous commitment management grouping (compliance requirements and deadlines), an emergency management grouping planning for and response to unscheduled releases, and a facility management grouping that can be used by or for response to a regulatory agency. Note abstract of Sturgeon.

In response to appellants' arguments on page 18 that claims 1, 24, 28, and 38 recite scheduling an appropriate resource to a particular event, (i.e., a natural gas line repair, service, inspection, follow-up, etc.), it is noted that the features upon which applicant relies (i.e., a natural gas line repair, service, inspection, follow-up) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellants further agued on page 19 that Sturgeon et al also fails to disclose a computer system including a main computer and a remote computer adapted to communicate with the main

computer, the remote computer accessing a remote program operative to display and modify only a remote portion of the plurality of compliance events and only a remote portion of the plurality of resources of the database. In response, the examiner respectfully disagrees. Sturgeon et discloses a computer and display system for communication purposes. Note col. 23 line 60 through col. 24 line 40.

In response to appellants' arguments on page 19 that Sturgeon fails to disclose remote program operative to display and modify only a remote portion of the plurality of compliance events and only a remote portion of the plurality of resources of the database, it is noted that the features upon which applicant relies (i.e., display **and modify** only a remote portion ...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant further argued the Examiner has failed to establish a Prima Facie Case on pages22-25. The examiner respectfully disagrees because all the conditions to establish a prima facie case of obviousness are met in the final office action. The combined teachings of Sturgeon et al and Dialog teaches the claimed invention, as analyzed above and presented in the final office action. Moreover, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combining Sturgeon et al with Dialog would have

been obvious to a person of ordinary skill in the with the motivation to allow users to effectively receive and transmit information.

For the reasons above, it is believed that the rejection of claims 1-XXX are sustainable.

Respectfully submitted,

Romain Jeanty
Primary Examiner
Art Unit 3623

RJ
June 23, 2007

Conferees

Vincent Millin
Appeal Specialist

Alexander Kalinowski
Supervisor AU 3691

Hunton & Williams LLP
19 K Street, N.W.
Washington, D.C. 20006-1109